

REMARKS

This paper is in response to the Office Action dated December 17, 2009. Claims 7 – 10 stand withdrawn. Claim 1 is amended and claims 2 – 4 are canceled. Claims 1 and 5 are under examination. Entry of this response, reconsideration and reexamination of the above-identified application are respectfully requested.

Applicants respectfully traverse the § 103(a) rejection of claims 1 – 5 (now 1 and 5) as being unpatentable over Soejima in view of Oguta et al..

By way of summary, the presently claimed invention relates to a method for preventing damage to trees caused by harmful insects by injecting into a tree an aqueous composition containing as active ingredient a neonicotinoid-based insecticide (clothianidin or dinotefuran), a surfactant for which the type and amount are limited, and a water-miscible organic solvent, and injecting that composition within the tree body to prevent and eradicate various harmful insects while causing no chemical damage.

The disclosure of Soejima is limited to a solubilized formulation for protecting pine trees from withering by injecting into the trees that contains (i) an insecticide and/or a fungicide having a water-solubility less than 5g/l, (ii) a solubilizing agent containing a nonionic surfactant having the HLB greater than 12 and (iii) water and/or a solvent miscible with water. The insecticide is preferably at least one selected from organophosphorus insecticides, benzimidazole antiparasitics, carbamate insecticides, synthetic pyrethroid insecticides, insect growth regulators, miticides and macrolide antibiotics. For example, a formulation containing the organophosphorus insecticide fenitrothion is reportedly effective against the pine wood nematode *Bursaphelenchus xylophilus* (not an insect pest).

In contrast, the method of the present claims pertains to a method for preventing damage to trees caused by harmful insects with a composition comprising a neonicotinoid-based insecticide, clothianidin or dinotefuran. One of ordinary skill in the art would not expect an organophosphorous - fenitrothion tree injection composition for controlling nematodes could be modified with a neonicotinoid-based insecticide for controlling harmful insects.

The secondary reference to Ogura et al. does not remedy the deficiencies of Soejima. More particularly, Ogura et al. contains a long list of insecticides that can be used as mix partners with certain ethylene derivatives described therein. This disclosure does not teach or suggest that fenitrothion can be replaced by clothianidin in a tree injection composition for treatment of pine withering caused by nematodes. There is no reasonable expectation of success in such a modification nor would it result in the presently claimed method.

Applicants respectfully submit that in reaching a conclusion of obviousness, the Patent and Trademark Office must consider the "invention as a whole," which includes evidence of the invention's unexpected results. See In re Margolis, 228 USPQ 940 (Fed. Cir. 1986). Specifically, the data in Tables 5 – 8 of the instant specification clearly support the patentability of the instant claims. Use of the neonicotinoid-based insecticide thiamethoxam is shown to be superior to the organophosphorous compound fenitrothion for controlling insects by tree injection. The improvement in efficacy is both surprising and unexpected; therefore the inventive selection of certain neonicotinoid-based insecticides, clothianidin or dinotefuran for tree injection is not obvious from the teaching of the cited prior art.

Applicants respectfully submit that the amended claims are patentable over Soejima in view of Ogura et al.. Reconsideration and withdrawal of the §103(a) rejection are respectfully requested.

Applicants traverse the provisional rejection of the claims under judicial doctrine as being unpatentable over certain claims of copending application 10/598,615. Applicants respectfully submit that the present claims are not obvious over claims 1 – 5 of the '615 application. Nevertheless, a terminal disclaimer will be taken under advisement once allowable subject matter has been identified in claims 1 and 5 herein.

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Response Dated June 17, 2010
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Applicants aver that a complete response to the office action has been made and that the instant application and claims are now in condition for examination on their merits and for allowance.

Respectfully submitted,

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